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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,819

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Peter Kacev

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INTELLECTUAL PROPERTY DEPARTMENT

SANTA MONICA, CA 90404

EXAMINER

TRIEU, THAI BA

ART UNIT

PAPER NUMBER

3748

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,819	<b>Applicant(s)</b> KACEV ET AL.	
	<b>Examiner</b> Thai-Ba Trieu	<b>Art Unit</b> 3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) 6-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This Office Action is in response to the Amendment filed on May 21, 2008.

Claims 1 and 5 were amended;

Claim 3 was cancelled; and

Claims 6-12 have been withdrawn from consideration.

Applicant's arguments, see Pages 4-9, filed on May 21, 2008, with respect to the rejections of claims 1-5 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is set forth below.

### ***Oath/Declaration***

Oath/declaration filed on June 03, 2008 has been accepted.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Pielstick (Patent Number 2,682,365).***

**Regarding claims 1-2,** Pielstick discloses a component for a turbocharger (1, 2, 3), the component including:

a housing (Not Numbered) defining a chamber for a predetermined part of the turbocharger (1, 2, 3), the housing (Not Numbered) being a compressor housing (a portion on the side of the compressor 1) of the turbocharger (1, 2, 3) and having an air inlet (via 9) for receiving uncompressed air and an air outlet (via 8) for discharging compressed air to an engine (15); and

a jacket (11, 12, 13, 14) surrounding a periphery and at least one side face of the housing, the jacket (11, 12, 13, 14) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (13) and a fluid outlet (14);

in which the fluid path (11, 12, 13, 14) has the fluid outlet (14) situated at a furthestmost position on the housing from the fluid inlet (13) (See Figure, and Column 2, lines 13-40).

**Regarding claim 5**, Pielstick discloses a turbocharger (1, 2, 3) including a component comprising:

a housing (Not Numbered) defining a chamber for a turbocharger compressor (1), the housing having an air inlet (via 9) for receiving uncompressed air and an air outlet (via 8) for discharging compressed air to an engine (15); and

a jacket (11, 12, 13, 14) surrounding a periphery and at least one side face of the housing, the jacket (11, 12, 13, 14) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a

fluid path about the outer surface of the housing, the component having a fluid inlet (13) and a fluid outlet (14) (See Figure, and Column 2, lines 13-40).

***Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Griepentrog (Pub. Number EP 14941 A1).***

**Regarding claims 1-2,** Griepentrog discloses a component for a turbocharger, the component including:

a housing (3, 100) defining a chamber for a predetermined part of the turbocharger, the housing (3, 100) being a compressor housing of the turbocharger and having an air inlet (See arrow ↓ of Figure 1) for receiving uncompressed air and an air outlet (See arrow ↑ of Figure 1) for discharging compressed air to an engine (Not shown); and

a jacket (8) surrounding a periphery and at least one side face of the housing, the jacket (8) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing (3, 100) to define a fluid path about the outer surface of the housing, the fluid path having a fluid inlet (12, 14) and a fluid outlet (10);

in which the fluid path (8) has the fluid outlet (10) situated at a furthestmost position on the housing from the fluid inlet (12, 14) (See Figures 1-2, and Abstract).

**Regarding claim 5**, Griepentrog discloses a turbocharger including a component comprising:

a housing (3, 100) defining a chamber for a turbocharger compressor, the housing having an air inlet (See arrow ↓ of Figure 1) for receiving uncompressed air and an air outlet (See arrow ↑ of Figure 1) for discharging compressed air to an engine (Not shown); and

a jacket (8) surrounding a periphery and at least one side face of the housing, the jacket (8) being arranged in a spaced relationship relative to an outer surface of the periphery and at least one side face of the housing to define a fluid path about the outer surface of the housing, the component having a fluid inlet (12, 14) and a fluid outlet (10) (See Figures 1-2, and Abstract).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Pielstick (Patent Number 2,682,365) or Griepentrog (Pub. Number EP 14941 A1), in view of Johnston et al. (Patent Number 5,857,332).***

Pielstick/Griepentrog discloses the invention as recited above; however, Meiners fails to disclose the jacket being of aluminium and attached to the housing by welding.

Johnston teaches that it is conventional in the supercharged internal combustion engine art, to utilize the jacket being of aluminium and attached to the housing. (See Column 3, lines 45-50).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the jacket being of aluminium and attached to the housing, as taught by Johnston, to provide the light weight for Pielstick/Griepentrog device.

Note that the claimed phrases “the jacket being attached to the housing by welding” are being treated as product by process limitation; that is, the jacket is formed to the housing by manufacturing, forming, casting, molding, shaping, punching and rolling. As set forth in MPEP 2113, product by process claims are NOT limited to manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 USC 102/103 rejection may be made and the burden is shifted to applicant to show an obvious difference. See MPEP 2113.

### ***Prior art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 4-5 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TTB  
July 8, 2008

/Thai-Ba Trieu/  
Primary Examiner  
Art Unit 3748